

REMARKS

Claims 20-23 are pending in the present application.

At the outset, Applicants wish to thank Examiner Dicus and Examiner Kelly for the helpful and courteous discussion with their undersigned Representative on April 13, 2004. At that time, various amendments and arguments were discussed to address the outstanding rejections. Reconsideration is respectfully requested in view of the amendments and remarks herein.

The rejection of Claims 20-21 under 35 U.S.C. §103(a) over Davis et al (US 4,480,066) in view of Takahashi et al (US 4,891,267) is obviated by amendment.

Applicants have amended Claim 20 to define the adhesive layer as containing a halogenated polymer-based adhesive selected from the group consisting of THIXON GPO and Metalock F-10 and having a thickness ranging from 5 μ m to 25 μ m. Applicants submit that at no point does either Davis et al or Takahashi et al disclose or suggest such a limitation.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation... to modify the reference... Second, there must be a reasonable expectation of success. Finally, the prior art reference... must teach or suggest all the claim limitations." (MPEP §2142) Applicants note that the combined disclosures of Davis et al and Takahashi et al fail to provide the requisite suggestion to modify the reference, much less suggest all the claim limitations and, therefore, the present invention would not be obvious in view of the references.

During the discussion with Applicants undersigned Representative the Examiner indicated that trade names should not be claimed; however, MPEP § 2163.02:

An objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gostelli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).

Applicants submit that the disclosure of the present specification coupled with the knowledge generally available in the art, as evidenced by the **enclosed** data sheets for each of THIXON GPO and Metalock F-10 (with partial English translations), the skilled artisan would readily recognize that which they have invented. As such, no further amendment is believed to be necessary.

Applicants request withdrawal of this ground of rejection.

The rejection of Claims 22-23 (improperly listed as Claims 23-24) under 35 U.S.C. §103(a) over Davis et al (US 4,480,066) in view of Takahashi et al (US 4,891,267) and Hoppie et al (US 4,478,777) and further in view of Orndorff, Jr. (US 4,331,496) is traversed.

Claim 22 provides an elastomeric molding containing a shrinkage control material having a resilient metal wire; and a heat treated adhesive layer on the metal wire, the adhesive layer having adhesion to elastomeric material; and a elastomeric extrusion around an outer periphery of the shrinkage control material, the elastomeric extrusion being bonded by vulcanization to the shrinkage control material, wherein the metal wire is selected from the group consisting of a brass wire and a brass-plated steel wire, the adhesive layer comprises a chlorinated rubber and a chlorosulfonated polyethylene rubber, the adhesive layer is from 5 μm to 25 μm thick, and wherein the elastomeric extrusion comprises an ethylene-propylene-diene ternary copolymer.

Applicants note that none of the art of record disclose or suggest using an adhesive layer comprises a chlorinated rubber and a chlorosulfonated polyethylene rubber to improve

adhesion of a brass wire or a brass-plated steel wire to an elastomeric extrusion of an *ethylene-propylene-diene ternary copolymer*.

Citing *In re Royka*, MPEP §2143.03 states: “to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” Applicants submit that this combination of disclosures fails to present even a *prima facie* case of obviousness against the pending claims.

Furthermore, when an Examiner maintains that there is an implicit teaching or suggestion in the prior art, “the Examiner should indicate where (page and line or figure) such a teaching or suggestion appears in the prior art.” (*Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (**copy enclosed**)). However, in the present application the Examiner has not indicated where, if at all, each claim limitation may be found in the art of record.

Therefore, in view of the forgoing, the Office has not met the burden necessary to establish a *prima facie* case of obviousness. Accordingly, Applicants respectfully request withdrawal of this ground of rejection.

Applicants submit that the present application is now in condition for allowance.

Early notification of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



Vincent K. Shier, Ph.D.
Registration No. 50,552

Customer Number

22850

(703) 413-3000
Fax #: (703)413-2220
NFO/VKS